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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

03001

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on April 21, 2006Signature William R BerggrenTyped or printed name William R Berggren

Application Number

10/749,601

Filed

12/31/2003

First Named Inventor

Hoopman, Timothy L.

Art Unit

3711

Examiner

Layno, Benjamin

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96).

☒ attorney or agent of record. 42,317
Registration number

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

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April 21, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below.

☒ *Total of 2 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Timothy L. Hoopman

Title: Cards for Columnar Card Games

Filed: December 31, 2003

Examiner: Benjamin Layno

Ser. No. 10 / 749,601

Art Unit: 3711

Mail Stop AF
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

This is a Pre-Appeal Brief Request for Review of the final rejection of the claims of the above application that was mailed from the United States Patent and Trademark Office on January 23, 2006. It is Applicant's position that there are clear errors in the Examiner's rejections and that examiner has omitted one or more essential elements needed for prima facie rejections under either 102(b) or 103.

Please find the following::

1. Notice of Appeal
2. Pre-Appeal Brief Request for Review Cover Form
3. Pre-Appeal Brief Request for Review beginning on page 2 of this paper
4. Check for Notice of Appeal fee of \$250.
5. A return postcard signifying receipt of this paper,

Pre-Appeal Brief Request for Review

The final office action was mailed on January 23, 2006. Examiner states that Claims 1-17 were rejected under 35 U.S.C. 102(b) and 35 U.S.C. 103 as being anticipated by or obvious over *Stauff* for at least one of four reasons: (1) the prior art is “capable” of lessening columnar length, (2) “horizontally proximate” is a relative term that can be broadly interpreted to include the prior art, (3) elements of the claimed invention that differ from the prior art are un-patentable printable subject matter, and (4) there is no novel or unobvious functional relationship between the printed matter and the substrate of the invention. Each of these reasons for rejection reflects clear error by Examiner that has resulted in omission by Examiner of one or more essential elements needed for a prima facie rejection. Examiner’s sole prior art reference to support his position is *Stauff*, D181,884.

Background

The facts of the case are as follows. Applicant’s invention is for a pack of playing cards for use in columnar games like bridge or solitaire that result in shorter lengths of columns. This is well described in the background, specification and Rule 132 Affidavit. Specifically, the invention is defined in claim 1 of the utility patent application as a pack of playing cards comprising cards having indicia in judicious placement to lessen both precision of vertical columnar alignment and columnar length over that obtainable with a previously known pack of playing cards. Claims 2-7 claim more detailed structures with first indicia in corners and second indicia horizontally proximate to first indicia with the same reading orientation, and some embodiments are shown in Fig. 4-6. Claims 8-17 claim structures where second indicia are in a region extends between two corner first indicia but not including a position proximate the secondary corners, and the cards have a central graphic with a split mirror image, and some embodiments are shown in Fig. 1,3.

Stauff is a design patent that claims cards having an appearance shown in the figures.

A supportable rejection under 35 U.S.C. 102(b) requires that one reference shows all elements of the rejected claims. A supportable rejection under 35 U.S.C. 103 requires that all elements of the claimed invention must be suggested or taught by one or more references

Rejection 1 - “Capable”

Examiner states that *Stauff* “discloses a pack of playing cards having many of the features recited in claims 1-17. “The first indicia (numerical value) in the primary corners and secondary corners are clearly horizontally aligned with the second indicia (suit) in a region bordering the top edge and bottom edge. The judicious placement of the second indicia (suit)”... “make the playing cards **capable** of lessening the precision of vertical columnar alignment and columnar length over that obtainable with previously known packs of playing cards.”

Stauff being **capable** of permitting less precise and shorter columnar arrangements is insufficient for a rejection under 35 U.S.C. 102(b) or under 35 U.S.C. 103. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil of California*, 814 F.2d.628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). A prima facie case of an obviousness rejection requires that the examiner present evidence that teaches or suggests the claimed invention. This can done only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual” to make that change.” *Stauff* is a design patent with no suggestion of changing the claimed designs to render the upper second indicia in a right-reading orientation or of using numbers as second indicia and suits as first indicia, an embodiment of the claimed invention. Thus not all elements are taught or suggested and both the anticipation and obviousness rejections are improper and should be withdrawn.

Rejection 2 - Broad Interpretation of “Horizontally Proximate”

“The examiner takes the position that the term ‘horizontally proximate’ is a relative term that is open to broad interpretation” to allow *Stauff* to anticipate the invention or make it obvious.

Claim language is read in light of the specification. Claims 2-7 and Fig 4-6 claim and teach embodiments where the second indicia are proximate to first indicia. Specification uses proximate and adjacent interchangeably. Claims 9-17 and Fig1,3 claim and teach embodiments where the top **region** containing the second indicia (not the second indicia) borders the top edge and extends to the right of the right-reading first indicia but not within a **region** proximate to the

secondary corner. Nothing in the claims or specification permit a broad interpretation made by the examiner. Thus not all elements are taught and the anticipation rejection is not proper and should be withdrawn.

Rejection 3 - Un-Patentable Printable Subject Matter

The Examiner also states that *Stauff* differs in right-reading orientation and upside-down-reading orientation of second indicia [as suits], an absence of second indicia proximately below or above first indicia in secondary corners [claimed in dependent claims 3, 5, 13 & 16], and face cards not having split orientation central graphics that seem similar whether seen right-side up or upside down. However, Examiner holds that these differences reside in the meaning and information conveyed by printed matter and are not considered patentable, citing *In re Breslow*, 192 USPQ 431 (PTOBA, 1975).

This is contrary to the holdings of MPEP (2106IV1(a)) and the Court of Appeals, Federal Circuit (CAFC). The above statement by the examiner comes from a dissenting opinion of the 1979 PTO Board of Appeals case and not from the ruling opinion that reversed the obviousness rejection. CAFC clarified the issue in *In re Gulack*, 217USPQ 405 (CAFC, 1983) by saying that “the fact that printed matter by itself is not patentable subject matter, becomes non-statutory, is no reason for ignoring it when the claim is directed to a combination.” Here the claim is directed to the combination of cards and judiciously placed indicia. This argument is more fully discussed in the Response to the Second Office Action. Thus because the printed matter is part of a combination and should be evaluated for patentability, this rejection is not proper and should be withdrawn.

Rejection 4 - No Novel or Unobvious Functional Relationship Between the Printed Matter and the Substrate of the Invention

Examiner states that, alternatively, invention is obvious in light of the prior art because there is no novel or unobvious functional relationship between the printed matter and the substrate of the invention.

CAFC in *In re Gulack*, 217USPQ 405 (CAFC, 1983) further states that “the critical question is whether there exists a new and unobvious functional relationship between the printed matter and the substrate.” In *In re Gulack*, the new and unobvious relationship was a sequence of numbers having a repetitive order, where the numbers were arranged in a continuous loop on a band, e.g., a hat band. Re the invention, the new and unobvious functional relationship is that the combination permits columns of shorter length, a result with significant benefits in games like Solitaire when played on small tables like airplane and hospital trays or and Bridge, particularly Contract Bridge where tables are many and smaller than normal (see Specification pages 1-6, 11, 21). Right-reading orientation is essential to solve the problems stated in the Background of the Specification where indicia that are upside-down can be misleading, e.g., “6” & “9” where an embodiment of the invention has second indicia as numbers. Split central graphics provide the card a familiar appearance that is desirable when used for competitive Contract Bridge tournaments (Claim 8 & Specification p 7-8, 17). This argument is further described in Response to Second Office Action.

As mentioned above, Examiner has not shown references anticipating the claimed elements, or teaching or suggesting them to support his bald argument that the combination is not novel or unobvious. Thus this argument is not proper and should be withdrawn.

Conclusions

Because of the above remarks, Applicant respectfully requests that the rejections be withdrawn and present application be allowed.

Customer Number 44977

CERTIFICATE UNDER 37C.F.R. 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to Commissioner for Patents, P.O. BOX 1450, Alexandria, VA 22313-1450 on this 21st day of April 2006.

Respectfully submitted,



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